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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,652	07/25/2003	Scott Basyl Johnston	A4Z01	1402

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EXAMINER

WRIGHT, ANDREW D

ART UNIT PAPER NUMBER

3617

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,652

Applicant(s)

JOHNSTON, SCOTT BASYL *ST*

Examiner

Andrew Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Australia on 7/24/02. It is noted, however, that applicant has not filed a certified copy of the 2002950341 application as required by 35 U.S.C. 119(b).

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the collar being selectively adjustable (claim 6), the projecting means received in the receiving means (claim 11), the tongue and groove (claim 12), one housing having both parts of the cooperating means (claim 13), the anti-slipping device (claim 14), the gasket (claim 15) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 9 is are objected to. Claim 9 recites "the display panel". This should be "the display portion". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3, 4, 8, 10-14, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

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6. Claim 4 recites "the top or upper edge of the housing". This recitation lacks antecedent basis in the claims. A top or upper edge has not been positively recited. A housing does not necessarily have a top or upper edge. Antecedent basis is explained in MPEP §2173.05(e):

A claim is indefinite when it contains words or phrases whose meaning is unclear. The lack of clarity could arise where a claim refers to "said lever" or "the lever," where the claim contains no earlier recitation or limitation of a lever and where it would be unclear as to what element the limitation was making reference. Similarly, if two different levers are recited earlier in the claim, the recitation of "said lever" in the same or subsequent claim would be unclear where it is uncertain which of the two levers was intended. A claim which refers to "said aluminum lever," but recites only "a lever" earlier in the claim, is indefinite because it is uncertain as to the lever to which reference is made.

7. Claim 3 recites "another housing". It is unclear how the housing of claim 1 can comprise another housing. Care should be taken to avoid using the same term to refer to different parts. The housing as recited in claim 1 is the entire apparatus. Reciting that the housing has another housing as a component of itself makes the claim unclear. Claims 11, 13, and 14 have similar recitations, and are rejected for the same reason. Furthermore, claim 13 recites "the one housing" and it is unclear which of the housings of claim 11 is being referred to. Claim 12 depends from claim 11 and is rejected for the same reason.

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8. Further regarding claim 11, the recitation of “the cooperating means” lacks antecedent basis in the claims. Claim 11 depends from claim 2. Claim 2 recites a “cooperating means for cooperatively engaging...” and claim 2 also recites “a complementary cooperating means”. It is unclear which of these is being referred to in claim 11.

9. Claim 8 recites “risers” and “flanges”. It is unclear if this is the same as the already recited “at least two collar portions” recited in claim 5, or if this refers to different structural elements. If it refers to the collar portions, then it is improper to positively recite the same element twice. If it does not refer to the collar portions, then there appears to be a 35 USC 112 1st paragraph enablement issue. Clarification is requested.

10. Regarding claim 10, the phrase “such as” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Furthermore, claim 10 recites the limitation “the collar portion” in line 4. There is insufficient antecedent basis for this limitation in the claim. It is unclear which of the already recited collar portions (from claim 5) is being referred to.

11. Regarding claim 10, the phrase “or similar” renders the claim indefinite because it is unclear what the definition of “similar” is in this case. Similar is a subjective concept and what one person thinks is similar may be different from what another person thinks is similar.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 4, 9, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Olsen (US 6,186,454). Olsen shows a housing for use as a sign comprising contact portion (16, 18), display portion (12), and means for fastening (22, 30). The size of the contact portion is selectively adjustable.

14. Regarding claim 4, the contact portion is located toward the top of the housing relative to the bottom surface of the housing.

15. Regarding claim 9, the display portion (12) has a pocket (42).

16. Regarding claim 16, the support element is a pole.

17. Claims 1-3, 5-8, and 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hutton et al. (US 5,560,093). Housing (13) comprises contact portion (22, 23), display portion (27), and means for fastening (37). The housing (13) can be flexed to open and close the slit (column 2, lines 59-66). Therefore the size of the contact portion, which is formed integrally with the housing (13), can be selectively adjustable.

18. It is noted that the claim 1 recitations “for displaying or presenting the indicia...” and “to accommodate attaching the housing...” are intended use recitations. A

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recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the structure is capable of performing the intended uses.

19. Regarding claim 2, means for cooperatively engaging is coupling (15). The complementary cooperating means is edge (21).

20. Regarding claim 3, the coupling is attached to edge (20) of the housing. The other edge (21) is the another member and constitutes an element.

21. Regarding claims 11-13, the cooperating means comprises an projecting means (20) and a receiving means (18). The cooperating means is a tab (20) and slot (18). Both the tab and slot are on the same housing

22. Regarding claim 5, the contact portion is collars (22, 23). Each collar has multiple stepped and concentric portions (see figures 1 and 2).

23. Regarding claim 6, the collar portion is adjustable by flexing the housing, which in turn adjusts the size of the collar portions.

24. Regarding claim 7, the collar portions are adjustable. The process by which adjustment is achieved is not given patentable weight in an apparatus claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the

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structure implied by the steps. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP 2113.

25. Regarding claim 8, each collar has plural flanges (horizontal sections shown in figures 1 and 2) and risers (vertical sections).

26. Regarding claim 10, the fastening means is elongate band (37) which is wrapped around the exterior surface of the collar portions. The band necessarily has some degree of flex to it, so it is flexible.

27. Regarding claims 14 and 15, Hutton shows that foam (76) can be used between the contact portion and the support element. Foam can be a gasket. Foam can be an anti-slipping device.

28. Regarding claim 16, the support element is a pole (10).

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Webb ('580) shows a pole sign with a display portion and clamping bands. McGuire ('546) shows a pole sign. Hart et al. ('899) shows a pole sign with bands around a collar. Mollet, III ('450) shows a pole sign with bands around a collar. Clausen ('801) shows a pole sign with display portions. Power et al. ('204) shows a pole sign with interconnecting housing portions. Branch, Jr. et al. ('858) shows a pole sign with interconnecting housing portions, a collar portion, and clamping bands.

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Cooper et al. ('170) shows a pole sign with interconnecting housing portions, a collar portion, and clamping bands.

30. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

on _____
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

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Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)_____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

31. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

32. If applicant chooses to continue prosecution alone, a proper response to an Office Action should include:

- (a) Acknowledgement of objections to the drawing and/or specification by specific instructions to correct these defects, and
- (b) Instruction to cancel or amend the rejected claims, or to substitute or add claims to be considered by this Office (all amendments must comply with 37 CFR 1.121 (available at the www.uspto.gov website)), or
- (c) An argument under the heading "Remarks" in which Applicant points out wherein he may disagree with Examiner's contentions and wherein he also discusses the references applied against his claims, explaining how his claims avoid these references or distinguish from them in a patentable sense.

An example of a proper response to an Office Action can be found at:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/formatrevamdtprac.pdf>

33. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright
Patent Examiner
Art Unit 3617

Apr 9-15-04
**ANDREW D. WRIGHT
PRIMARY EXAMINER**